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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,067	01/14/2004	Jonathan J. Hull	015358-004031US	5097
20350	7590	04/18/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			WALLERSON, MARK E	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2625	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/758,067	Applicant(s) HULL ET AL.	
	Examiner Mark E. Wallerson	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/6/06</u> | 6) <input type="checkbox"/> Other: _____ |

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **2/6/2006**.

2. This application has been reconsidered. Claims 20-32 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claims 25 and 29, Applicant has amended these independent claims to include the limitation that *“the storing of [the] image data in the at least one database is separate from the transmission of the email document to the destination.”* There is no disclosure (to the Examiner’s satisfaction), of this limitation. In fact, the disclosure in the specification on page 11 line 30 to page 12, line 22 of the original specification directly contradicts this limitation. The original specification states that email messages **sent and received** (reads on transmitted emails) by a user can be captured on the client system 102 or at an email hub 116 (page 11, lines 30-32). If Applicant believes this rejection to be in error, Applicant is requested to specifically point out support for this subject matter in the original specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 25, 26, 27, 29, 30, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Todd (U.S. 5,890,163).

With regard to claims 25, 27, 29, and 31, Todd discloses an email server (column 4, lines 32-34) for performing unconscious archiving of electronic documents in a network environment (column 2, lines 7-30), wherein electronic documents are transferred over a network (figure 2) coupling at least one client computer (20) and at least one document management workstation (26) having at least one database (50) disposed to receive electronic copies of the documents for archiving (column 2, lines 7-30), the server operatively disposed to collect electronic image data of an email document transmitted over the network (figure 1), wherein the email document was

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transmitted in response to a single user input command (column 2, lines 17-22) configured to transmit the email document to a destination, the electronic image data being a copy of the email document transmitted over the network (column 2, lines 7-30); cause said image data to be stored in the at least one database to perform the unconscious capture archiving (column 2, lines 7-30), wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command for transmitting the email document to a destination, wherein the storing of the image data in the at least one database is separate from the transmission of the email document to the destination (the storage occurs after transmission of the email) (column 2, lines 7-30).

With respect to claims 26 and 30, Todd discloses a destination client system (figure 1 and column 1, lines 52-63).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20, 21, 22, 23, 24, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of Bellemare et al (Bellemare) (U.S. 5,701,183).

With respect to claims 20, 21, 22, 28, and 32, Todd discloses an email server for performing unconscious archiving of electronic documents in a network environment (column 2, lines 7-30 and column 4, lines 16-34), wherein electronic documents are transferred over a

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network coupling at least one client computer and at least one document management workstation (figure 2) having at least one database (50) disposed to receive electronic copies of the documents for archiving (column 2, lines 7-30), the server operatively disposed to collect electronic image data of each and every email document in a plurality of email documents transmitted over the network (column 2, lines 7-30) in response to a single user input command (column 2, lines 7-30) the electronic image data being a copy of each and every email document transmitted over the network (column 2, lines 7-30); cause the image data to be stored in the at least one database (50) to perform the unconscious capture archiving, wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command, and the aforementioned steps capture electronic document images of the plurality of email documents transferred over the network (column 2, lines 7-30).

Todd differs from claims 20, 22, 28, and 32 in that he does not clearly disclose that the database comprises image data from a copy, print, or facsimile function.

Bellemare discloses an apparatus for the selective archiving of facsimile messages (column 4, lines 24-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Todd to store images from a copy, print or facsimile function. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Todd by the teaching of Bellemare in order to obtain a variety of image data in the database.

With regard to claims 23, Todd discloses storing addresses for the email (column 5, lines 12-37).

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With respect to claim 24, Todd discloses storing a transmission date of the email (column 7, lines 24-32 and column 9, lines 4-7).

Response to Arguments

9. Applicant's arguments filed 2/6/2006 have been fully considered but they are not persuasive. With respect to claims 25 and 29, Applicant submits that Todd does not disclose the unconscious archiving of an email via a single user input command. The Examiner disagrees. Todd clearly discloses the automatic (unconscious) archiving of email messages based on a single instruction of a user (column 2, lines 7-30).

Applicant further submits that Todd does not disclose archiving email data along with copy, print and facsimile data. The Examiner disagrees, and first submits that Applicant is arguing subject matter not being claimed. Claims 20, 21, 22, 28 and 32 disclose archiving at least one of a copy, print, and facsimile image, not all three. Nevertheless, Bellemare is used for this limitation and clearly discloses the archiving of facsimile images (the abstract).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Todd and Bellemare would allow a user to store a variety of document images.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

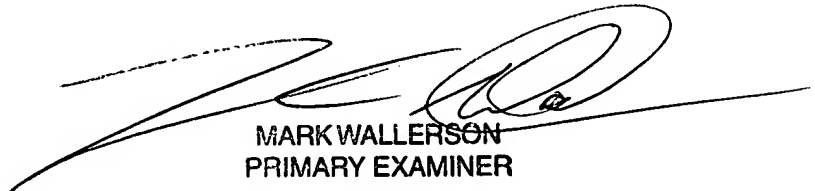
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER